

REMARKS

In the Office Action, Claims 1-39 were examined and stand rejected. In response to the Office Action, Claims 1, 7, 9, 17, 22, 23, 29, 33 and 37 are amended, no claims are cancelled and no claims are added. Applicants respectfully request reconsideration of pending Claims 1-39 in view of the following remarks.

I. Claims Rejected Under 35 U.S.C. §103

The Examiner has rejected Claims 1-39 under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent No. 6,512,919 issued to Ogasawara ("Ogasawara") in view of EP Patent Application No. 0 905 953 to Colavin ("Colavin"). Applicants respectfully traverse this rejection.

Regarding Claims 1 and 9, Claims 1 and 9 are amended to recite the following claim features, which are neither disclosed nor suggested by the combination of Ogasawara and Colavin:

scanning one or more product barcodes to generate an optical barcode signal;
converting the optical barcode signal into audio barcode tones to form an audio barcode signal. (Emphasis added.)

As correctly recognized by the Examiner, Ogasawara is silent on the conversion of product barcodes into audio tones and transmitting scanned barcodes as audio tones. (See, pg. 3, lines 1-2 of Office Action mailed October 5, 2005.) As a result, the Examiner cites Colavin. Colavin describes a telephone system equipped with a barcode reader for automated dialing and information transmission. Regarding the scanning of barcodes, Colavin teaches:

scanning a bar code with a bar code reader 24 producing electrical pulses representative of the bar code; decoding the electrical pulses into characters of a telephonic character set; and generating DTMF pulses representative of the characters of the telephonic character set over the telephone network. (col. 5, lines 23-29.) (Emphasis added.)

As further illustrated with reference to FIG. 5 of Colavin:

a flow chart 50 illustrates the translation of electrical pulses from a bar code reader into DTMF pulses over a telephone network according to the present invention is illustrated. In Block 52, the electrical pulses from the bar code reader is decoded into characters of a telephonic character set containing numbers and symbols. Next, as illustrated in Block 54, the sequence of numbers and symbols

are interpreted into either a telephone number or plain data. DTMF pulses, consisting of numbers, symbols, and pauses, are generated and transmitted over the telephone network as illustrated in Block 60. (col. 6, lines 22-33.) (Emphasis added.)

As indicated by the cited passages above, the scanning of a barcode by a barcode reader 24 produces electrical pulses representative of the barcode. As shown in FIG. 5 of Colavin, the electrical pulses from the barcode reader are decoded into characters of a telephonic character set containing numbers and symbols. (See, supra.) This conversion is required since the disclosure in Colavin is limited to the transmission of such barcode information into dual tone multi-frequency (DTMF) pulses representative of the characters of the telephonic character set for transmission over a telephone network. (See, supra.)

In contrast, as recited by amended Claims 1 and 9, the initially scanned barcodes generate an optical barcode signal, which is converted into audio barcode tones to form an audio barcode signal. Applicants respectfully submit that the conversion of electrical pulses received from a barcode reader into characters of a telephonic character set for generating DTMF pulses representative of the characters of the telephonic character set over a telephone network (see, col. 5, lines 23-25 of Colavin) fails to teach or suggest the conversion of an optical barcode signal generated from scanning of one or more product barcodes, into audio barcode tones, to form an audio barcode signal, as recited by amended Claims 1 and 9.

As mandated by case law, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (C.C.P.A. 1974).

Here, the disclosure in Colavin is expressly limited to the decoding of electrical pulses produced by a barcode reader from scanning of a barcode into characters of a telephonic character set and the generation of DTMF pulses representative of the characters of the telephonic character set for transmission over a telephone network. (See, col. 6, lines 22-23.) Applicants respectfully submit that the decoding of electrical pulses into characters of a telephonic character set for generation of DTMF pulses representative of the characters of the telephonic character set, as disclosed by Colavin, fails to teach or suggest the conversion of an optical barcode signal generated from scanning of one or more product barcodes into audio barcode tones to form an audio barcode signal, as recited by amended Claims 1 and 9.

In contrast to the above-recited features of amended Claims 1 and 9, Colavin discloses, with reference to FIG. 6, a flowchart that illustrates data type handling. As disclosed by Colavin:

a data type symbol is desirable to be used by the present invention as a prefix to indicate if the encoded number must be interpreted as a phone number or rather as plain data. If a data type symbol is encountered then the data type is determined as described in Decision Block 56. If the data type is plain data, then execution continues with no translation. Plain data is defined as telephone data that is not used for dialing purposes, such as credit card information, confidential information, or any other telephone data that is transmitted over the telephone after a telephone connection is established. If the data type is a phone number, then execution continues at Block 58. In Block 58, the telephone number may be translated, as required, such as adding a prefix. (col. 6, lines 38-52.) (Emphasis added.)

As indicated by the cited passage above, Colavin defines plain data as telephone data that is not used for dialing, including credit card information, confidential information or other telephone data transmitted over the telephone after establishment of a telephone connection. Applicants respectfully submit that the combination of plain data along with phone number information and the use of a data type to indicate if an encoded number must be interpreted as a phone number rather than plain data, as disclosed by Colavin, clearly illustrates that the generation of DTMF pulses, as disclosed by Colavin, do not represent audio barcode tones. As disclosed by Colavin, the DTMF pulses represent either plain data that is transmitted over a phone subsequent to a telephone connection or a phone number, as is indicated by the data type symbol.

Accordingly, Applicants respectfully submit that generating audio barcode tones by converting an optical barcode signal to form an audio barcode signal, as recited by Claims 1 and 9, is neither taught nor suggested by Colavin. Conversely, the signal generated by Colavin will include plain data, such as credit card information, confidential information or other telephone data that is transmitted over a telephone subsequent to establishment of a telephone connection. (See, col. 6, lines 38-52 of Colavin.)

Therefore, Applicants respectfully submit that the combination of Ogasawara in view of Colavin fails to teach or suggest each of the above-recited features of amended Claims 1 and 9. Consequently, Applicants respectfully submit that the Examiner fails to establish a *prima facie* case of obviousness of amended Claims 1 and 9, since all claim limitations recited by amended

Claims 1 and 9 are not taught or suggested by the prior art combination of Ogasawara in view of Colavin. Id.

Therefore, for at least the reasons described above, Applicants respectfully submit that Claims 1 and 9, as amended, are patentable over the combination of Ogasawara in view of Colavin. Consequently, Applicants request that the Examiner withdraw the §103(a) rejection of Claims 1 and 9.

Regarding Claims 2-8, Claims 2-8, based on their dependency from Claim 1, are also patentable over the combination of Ogasawara in view of Colavin. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claims 2-8.

Regarding Claims 10-16, Claims 10-16, based on their dependency from Claim 9, are also patentable over the combination of Ogasawara in view of Colavin. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claims 10-16.

Regarding Claims 17 and 23, Claims 17 and 23 are amended to recite the following claim features, which are neither taught nor suggested by the combination of Ogasawara in view of Colavin:

receiving at least one product barcode encoded as audio barcode tones of an audio barcode signal;
decoding the audio barcode tones of the received barcode signal to determine a product identified by the product barcode; and
determining a lowest price available for online purchase of the product if a price comparison instruction is received as a product processing instruction.
(Emphasis added.)

According to the Examiner, the above-recited features of amended Claims 17 and 23 are disclosed by Ogasawara in view of Colavin. However, in contrast to the above-recited features of amended Claims 17 and 23, Ogasawara is directed to personal shopping systems. As disclosed by Ogasawara:

Thus, the present invention allows retailers to implement a personal shopping system while minimizing the cost investment necessary to do so. (col. 3, lines 17-20.) (Emphasis added.)

Applicants respectfully submit that the disclosure, teachings and suggestions from Ogasawara are directed to overcoming limitations associated with personal shopping systems.

As disclosed by Ogasawara:

It is also known to use a personal shopping system (PSS) wherein the purchaser carries a scanner embedded hand-held terminal within a store. Bar codes of products to be purchased are scanned with the hand-held scanner. A display on the scanner embedded hand-held terminal displays an item price and a running total of the purchase prices of the products which have been scanned. Payment for the scanned products is accomplished at a checkout counter in a conventional manner. (col. 2, lines 6-14.) (Emphasis added.)

However, as indicated by Ogasawara, contemporary personal shopping systems require substantial financial investment by retailers to provide the portable personal shopping system terminals. (See, col. 2, lines 15-21.) As a result, Ogasawara teaches that wireless video phones provide a cost-effective way of accommodating an electric shopping system. (See, col. 2, lines 47-57.)

As further disclosed by Ogasawara, a store maintains a server which provides a downloadable purchase transaction program to a purchaser's wireless video phone when the purchaser calls the store's server via the purchaser's wireless video phone. (See, col. 3, lines 21-25.) As further disclosed by Ogasawara:

A catalog 21 of the items which can be purchased contains a bar code 22 for each such item, and preferably also contains descriptive text 13 and a picture 15 of each item. The use of such a catalog 21 or the like facilitates the purchasing of products via the electronic shopping system of the present invention when the purchaser is not in the store where the items are sold. Typically, each item 33 also has a bar code 31 applied thereon. (col. 5, lines 41-48.) (Emphasis added.)

Accordingly, based on the cited passage above, Applicants respectfully submit that the electronic shopping system, as disclosed by Ogasawara, is limited to a single store and enables implementation of a personal shopping system by using a user's wireless video phone, which is downloaded with a purchase transaction program once the user has established a connection to a store's server. (See, col. 5, lines 49-59.) As further described by Ogasawara, a user may access a catalog of items available from the store when the user is not inside the store to enable purchase of items. (See, col. 5, lines 41-48.)

Conversely, as indicated by amended Claims 17 and 23, a lowest price available for online purchase of a product is determined if a price comparison instruction is received as a

product processing instruction. Applicants respectfully submit that since the teachings of Ogasawara are expressly limited to a single store, the teachings in Ogasawara teach away from a price comparison instruction for identification of a lowest price available for online purchase of an item since such instruction would lead to the consumer's purchase of a product online and not from the store, assuming a lower price is available for online purchase of the item. Regarding Colavin, Colavin fails to provide any teachings or suggestions regarding the price comparison instruction recited by amended Claims 17 and 23.

Consequently, Applicants respectfully submit that the Examiner fails to establish a *prima facie* case of obviousness of amended Claims 17 and 23 since the prior art combination of Ogasawara in view of Colavin does not teach or suggest each of the above-recited features of amended Claims 17 and 23. In re Royka, *supra*.

Accordingly, for at least the reasons provided above, Applicants respectfully submit that Claims 17 and 23, as amended, are patentable over the combination of Ogasawara in view of Colavin. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claims 17 and 23.

Regarding Claims 18-22, Claims 18-22, based on their dependency from Claim 17, are also patentable over the combination of Ogasawara in view of Colavin. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claims 18-22.

Regarding Claims 24-28, Claims 24-28, based on their dependency from amended Claim 23, are also patentable over the combination of Ogasawara in view of Colavin. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claims 24-28.

Regarding Claim 29, Claim 29 is amended to recite analogous claim features to those features of amended Claim 1. Consequently, Applicants arguments provided above with regard to the §103(a) rejection of Claim 1 as obvious in view of Ogasawara in view of Colavin equally apply to the Examiner's §103(a) rejection of Claim 29 as obvious over Ogasawara in view of Colavin.

Accordingly, for at least the reasons described above, Applicants respectfully submit that the combination of Ogasawara in view of Colavin fails to teach or suggest the conversion of an optical barcode signal generated from one or more scanned barcodes into audio barcode tones to

form an audio barcode signal, is neither taught nor suggested by the combination of Ogasawara in view of Colavin.

Consequently, Applicants respectfully submit that the Examiner fails to establish a *prima facie* case of obviousness of amended Claim 29, since the prior art combination of Ogasawara in view of Colavin fails to teach or suggest each of the above-recited features of amended Claim 29. In re Royka, supra.

Accordingly, for at least the reasons provided above, Claim 29, as amended, is patentable over the combination of Ogasawara in view of Colavin. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claim 29.

Regarding Claims 30-32, Claims 30-32, based on their dependency from amended Claim 29, are also patentable over the combination of Ogasawara in view of Colavin. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claims 30-32.

Regarding Claim 33, Claim 33 is amended to recite analogous claim features to those recited by amended Claims 17 and 23. Accordingly, Applicants' arguments provided above with regard to the §103(a) rejection of Claims 17 and 23 as obvious over the combination of Ogasawara in view of Colavin equally apply to the Examiner's §103(a) rejection of Claim 33 as obvious over the combination of Ogasawara in view of Colavin.

Therefore, for at least the reasons described above, Applicants respectfully submit that the Examiner fails to establish a *prima facie* case of obviousness of amended Claim 33, since the prior art combination of Ogasawara in view of Colavin fails to teach or suggest the determination of a lowest price available for online purchase of a product if a price comparison instruction is received as a product processing instruction. In re Royka, supra.

Consequently, for at least the reasons provided above, Applicants respectfully submit that Claim 33 as amended is patentable over the combination of Ogasawara in view of Colavin. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of amended Claim 33.

Regarding Claims 34-36, Claims 34-36, based on their dependency from Claim 33, are patentable over the combination of Ogasawara in view of Colavin. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claims 34-36.

Regarding Claim 37, Claim 37 is amended to recite the following claim feature, which is neither taught nor suggested by the prior art combination of Ogasawara in view of Colavin:

a transaction server computer to receive at least one audio barcode signal, to decode the received audio barcode signal to identify at least one product, and determine a lowest price available for online purchase identified product if a price comparison instruction is received as a product processing instruction. (Emphasis added.)

Applicants respectfully submit that the above-recited feature of amended Claim 37 is analogous to the above-recited feature of amended Claims 17, 23 and 33. Accordingly, for at least the reasons provided above, Applicants respectfully submit that Applicants' amendment to Claim 37 prohibits the Examiner from establishing a *prima facie* case of obviousness of amended Claim 37 since the prior art combination of Ogasawara in view of Colavin fails to teach or suggest the functionality performed in response to the price comparison instruction, as recited by amended Claim 37. In re Royka, *supra*.

Therefore, for at least the reasons provided above, Applicants respectfully submit that amended Claim 37 is patentable over the combination of Ogasawara in view of Colavin. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claim 37.

Regarding Claims 38 and 39, Claims 38 and 39, based on their dependency from Claim 37, are also patentable over the combination of Ogasawara in view of Colavin. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claims 38 and 39.

CONCLUSION

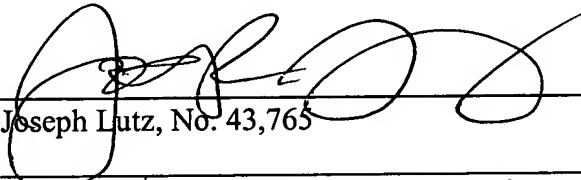
In view of the foregoing, it is submitted that Claims 1-39 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in move the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN, LLP

Dated: April 5, 2006

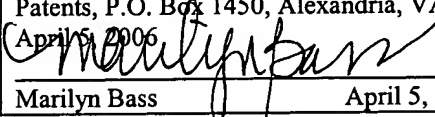


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Marilyn Bass

April 5, 2006